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HUMAN GENOME SCIENCES INC
9410 KEY WEST AVENUE
ROCKVILLE MD 20850

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OFFICE OF PETITIONS

In re Patent No. 6,531,447
Ruben et al.
Issue Date: March 11, 2003
Application No. 09/690,454
Filed: October 18, 2000
Atty Docket No. PZ006P1C1

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: LETTER REGARDING
: PATENT TERM ADJUSTMENT
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This letter is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed April 4, 2003. Applicants request reconsideration of the patent term adjustment indicated on the face of U.S. Patent No. 6,531,447, which issued from application No. 09/690,454 on March 11, 2003. Patentees request that the patent term adjustment be corrected from ZERO "0" days to THIRTY "30" days.

The request for reconsideration of the patent term adjustment indicated on the patent is **DISMISSED**.

On October 16, 2002, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 27 days. This calculation was based on an adjustment for PTO delay of thirty (30) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2) reduced by applicants' delay of three (3) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b). These calculations have been reviewed and found to be correct. On instant application for patent term adjustment, patentee does not dispute either of these calculations as made at the time of mailing of the Notice of Allowance.

Rather, patentees dispute the revised patent term adjustment. The application history reveals that the patent term adjustment was further reduced by applicants' delay of fifty-six (56) days pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 CFR 1.704(c)(10). Specifically, after the mailing of the Notice of Allowance on October 16, 2002, on January 15, 2003, applicants filed a paper entitled "Letter Making Patent Office Error of Record." The next response from the Office was issuance of the patent on March 11, 2003, fifty-six (56) days later. Accordingly, the patent term adjustment was properly reduced by 56 days.

However, patentees argue that the paper filed January 15, 2003, was erroneously entered as a 312 amendment, but they were not requesting such an amendment (which would constitute grounds for reducing the period of adjustment of patent term pursuant to § 1.704(c)(10)). Furthermore, patentees contend that the paper filed January 15, 2003, is not the type of paper which causes substantial interference and delay in the patent issue process, warranting reduction of the patent term adjustment. In support thereof, patentees cite 1274 OG 111 (June 26, 2001). Finally, applicants assert that the "Letter Making Patent Office Error of Record" should not be "considered a 'failure to engage in reasonable efforts' to conclude processing or examination of an application," since such a paper did not require any further action or consideration by the Patent Office.

Patentees' arguments are not well-taken.

37 CFR § 1.704(a) provides that:

The period of adjustment of the term of a patent under § 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination).

37 CFR § 1.704(c) further sets forth circumstances which the Director has determined constitute failure to engage in reasonable efforts to conclude processing or examination of an application. Specifically, § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months.

37 CFR § 1.704(c)(10) does not set forth any requirement that the Office show that the filing of the paper required any further action or consideration by the Patent Office. Rather, it clearly advises applicants that the submission of such a paper after the Notice of Allowance will reduce the patent term adjustment by up to four months.

The Notice cited by applicants, *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance*, 1247 OG 111 (June 26, 2001), set forth examples of papers that the Director has deemed not to cause substantial interference and delay in the patent issue process. These papers include (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not

small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). The Notice has, thereby, advised applicants that the submission of these papers, and these papers alone, after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and will not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

It is acknowledged that the paper filed January 15, 2003 was not an amendment under 1.312. However, the paper also was not of a type the Office has determined does not cause substantial interference and delay in the patent issue process. The paper submitted is not of the type identified in the Notice. Furthermore, the Office does not consider the paper warranting inclusion among the papers identified as clearly not causing substantial interference and delay in the patent issue process. In this paper, applicants assert that the Continuing Data provided to applicants on the official filing receipt mailed January 15, 2001 contained an error in the priority information. Further, applicants request that the letter be made of record pursuant to MPEP § 1480. In support thereof this submission included a copy of a postcard receipt and a copy of a preliminary amendment. Thus, this paper could be interpreted as requesting review of a filing receipt that was supplied to applicants more than 2 years prior. Alternatively, this paper refers to MPEP § 1480, which provides for issuance of a certificate of correction for Office mistake, which would not be appropriate in regard to an application that has not issued. Applicants did not cite to a rule which properly provides for the relief requested in this paper. Thus, it can be concluded that the time it would take for Office personnel to conclude the actions that needed to be taken, if any, in response to this letter could constitute substantial interference and delay in the patent issue process. Furthermore, applicants waited until after mailing of the Notice of Allowance to file this paper, when it could have been filed anytime after receipt of the filing receipt mailed January 15, 2001.

Accordingly, it is concluded that by submitting such a paper post-allowance, applicants have failed to engage in reasonable efforts to conclude processing or examination within the meaning of 1.704(c)(10).

Therefore, the further reduction of patent term adjustment was proper. The revised patent term adjustment of zero (0) days is affirmed.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Petitions Attorney, at (703) 305-0309.

Karin Ferriter
for
Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy